

REMARKS

In the Office Action dated December 7, 2006, claims 1, 3-8, 10-14, and 16-20 were presented for examination. Claims 10-13 were rejected under 35 U.S.C. §112, second paragraph. Claims 1, 3-8, 10-14, and 16-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Blumenau et al.*, U.S. Patent No. 6,845,395, in view of *Imamura et al.*, U.S. Patent No. 6,604,153. Claims 1,3-5,7, 8, 10-12, 14, and 16-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Kitamura et al.*, U.S. Patent No. 6,816,948, in view of *Imamura et al.*, U.S. Patent No. 6,604,153.

The following remarks are provided in support of the pending claims and responsive to the Office Action of December 7, 2006 for the pending application.

I. Rejection Under 35 U.S.C. §112

In the Office Action dated December 7, 2006, the Examiner assigned to the application rejected claims 10-13 under 35 U.S.C. §112, second paragraph. More specifically, with respect to claims 8 and 10, the Examiner raised a concern with the language “a label”. Applicants have amended this language in claim 10 to indicate that this term is previously referred to in claim 8. Accordingly, in view of the amendments to claim 10, Applicants respectfully request that the Examiner remove the rejection under 35 U.S.C. §112, second paragraph.

II. Rejection Under 35 U.S.C. §103(a)

In the Office Action of December 7, 2006, the Examiner assigned to the application rejected claims 1, 3-8, 10-14, and 16-20 under 35 U.S.C. §103(a) as being unpatentable over *Blumenau et al.* ‘395 in view of *Imamura et al.* ‘153.

Applicants’ remarks pertaining to both *Blumenau et al.* ‘395 and *Imamura et al.* ‘153 in prior communications is hereby incorporated by reference.

As noted by Applicants in the communication dated October 25, 2006, *Blumenau et al.* ‘395 pertains to identifying storage volumes on a storage system through a database. “A configuration database 32 (Fig. 3) stores information regarding which ones of the HBAs have access to which ones of the volumes. As discussed above, in one embodiment information in the configuration database is received from the system administrator and is periodically updated as the configuration of the network changes.” Col. 9, lines 17-22. *Blumenau et al.* ‘395 does not teach reading a storage media label and used data from this label as a comparison term.

Similarly, as noted by Applicants in the communication dated June 7, 2006 and acknowledged by the Examiner in the Office Action dated August 25, 2006, *Imamura et al.* ‘369 pertains to comparing a disk identifier with a memory identifier, for example a memory medium and a storage medium. “[I]t is unreasonable to consider such a disk a “node” as claimed.”¹ *Imamura et al.* ‘369 does not teach establishing access right of said nodes to said storage media.

It appears that the Examiner is dissecting the claimed elements and piecing them together with the prior art references. “When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.”² The Examiner may not use hindsight to reconstruct the elements of Applicants’ claimed invention. Rather, the Examiner must demonstrate how the prior art teaches the desirability and motivation for the alleged combination of the references. “Rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an ‘illogical and inappropriate process by which

¹See Office Action dated August 25, 2006, page 7, Section III, first paragraph.

²*In re Rouffet*, 149 F.3d 1350, 47 USPQ 2d 1453 (Fed. Cir. 1998) citing *In re Beattie*, 974 F.2d 1309, 24 USPQ 2d 1040 (Fed. Cir. 1992).

to determine patentability.’ ”³ However, as noted above, there is no teaching, suggestion, or motivation to modify the teachings of the prior art to produce the claimed invention external to Applicants’ pending claims. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggested the desirability of the combination.”⁴ It is clear that there is no teaching, suggestion, or motivation in the prior art references to combine them in the manner alleged by the Examiner. Accordingly, Applicants’ respectfully request removal of the rejection and direct allowance of claims 1, 3-8, 10-14, and 16-20.

With respect to claims 4, 5, 11, and 12, Applicants claim a type field to indicate node ownership or cluster ownership, respectively. The Office Action does not specify which prior art reference, *Blumenau et al.* or *Imamura et al.*, is being alleged to teach the elements of these two claims. In fact, it appears from the language of the Office Action that the Examiner is indicating that these elements are not found in either *Blumenau et al.* or *Imamura et al.*. As noted in the Office Action Response dated October 25, 2006, *Blumenau et al.* does not utilize a node identifier as a basis for the access right determination. *Blumenau et al.* also does not teach or suggest a clustering of nodes and an associated cluster identifier. Similarly, with respect to *Imamura et al.* and as noted in the Office Action Response dated December 7, 2005, “a disk identifier and a memory identifier are not equivalent or substitutable for a node and/or cluster identifier and do not determine access rights of a node to storage media.”⁵ “To establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations.”⁶ The Examiner is not citing any location in the prior art reference(s), or a specific prior art reference, that identifies node ownership or cluster ownership

³*In re Rouffet* citing *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.2d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

⁴MPEP §2143.01, citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

⁵See Office Action Response of December 7, 2005, page 11.

⁶MPEP §2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

in the manner claimed. Applicants' hereby maintain their position that neither *Blumenau et al.* nor *Imamura et al.* teach or suggest the node and/or cluster identifier(s) as claimed by Applicants. Accordingly, Applicants' respectfully request that the Examiner remove the rejection of claims 4, 5, 11, and 12 and grant allowance thereof.

With respect to claims 19 and 20, the Examiner uses a double negative to teach the omitted element. More specifically, the Examiner states, "Regarding claim 19, *Imamura* does not teach that the label does not contain a type field and node identifier. Regarding claim 20, *Imamura* does not teach that the label does not contain a type field and a cluster identifier."⁷ As noted above, "To establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations."⁸ It is clear in the law that the prior art must teach the claim limitations and the fact that the prior art does not teach that it does not contain a specific element is not sufficient to overcome the omitted element. The prior art must positively teach the omitted element of the claim limitation. Since the Examiner has not cited a teaching of the node and cluster identifiers in the manner claimed by Applicants, Applicants hereby maintain their position that neither *Blumenau et al.* nor *Imamura et al.* teach or suggest the node and/or cluster identifier(s) as claimed by Applicants. Accordingly, Applicants respectfully request that the Examiner remove the rejection of claims 19 and 20 and grant allowance thereof.

III. Rejection Under 35 U.S.C. §103(a)

In the Office Action of December 7, 2006, the Examiner assigned to the application rejected claims 1, 3-5, 7, 8, 10-12, 14, and 16-20 under 35 U.S.C. §103(a) as being unpatentable over *Kitamura et al.* '948 in view of *Imamura et al.* '153.

⁷Office Action dated December 7, 2006, page 5.

⁸MPEP §2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

Applicants' remarks pertaining to both *Kitamura et al.* '948 and *Imamura et al.* '153 in prior communications and above are hereby incorporated by reference.

As noted by Applicants in the Response dated December 7, 2005, it is acknowledged that *Kitamura et al.* '948 teaches a computer system with a plurality of hosts with each host having a port to facilitate communication with storage media. Furthermore, as acknowledged, by the Examiner, *Kitamura et al.* does not teach the hard attribute as claimed by Applicants.⁹

In order to combine prior art references under 35 U.S.C. §103(a), the prior art references must have a suggestion or motivation to modify the references or combine the teachings.¹⁰ “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants’ disclosure.”¹¹ As noted by the Examiner, *Kitamura et al.* is cited merely for its structure of a host in communication with storage media over a network.¹² The Examiner cited *Imamura et al.* to support the contention that the remaining claimed elements are taught therein. However, there is no motivation in the prior art references for combining *Kitamura et al.* and *Imamura et al.* Rather, the motivation for such a combinations stems from the language in Applicants’ claims.

Kitamura et al. teaches restricting access to storage media in a manner different than that claimed by Applicants. More specifically, Applicants restrict access to storage media based on a hard attribute, which may include a vendor number, product number, and/or serial number of the storage media. See amendment to claims 1, 8, and 14 submitted on December 7, 2005. In contrast, *Kitamura et al.* teaches a port identifier. As noted in prior communications, a port

⁹Office Action dated August 25, 2006, page 5.

¹⁰See MPEP §2143.

¹¹ MPEP §2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

¹² Office Action of December 7, 2006, page 5.

identifier is not associated with a label of the storage media and/or a hardware attribute as defined by the storage media label. There is no teaching or suggestion in *Kitamura et al.* to modify the invention to include the hardware attribute as claimed by Applicants. To modify the teaching of *Kitamura et al.* for the hardware attribute as claimed by Applicants would go against the teaching of *Kitamura et al.*.

Based upon *Kitamura et al.*'s teaching, it is clear that the Examiner is taking the elements of Applicants' pending claims and combining them in an improper manner. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious."¹³ Yet that is the very process that the Examiner has attempted to undertake. Most patents may be considered combination patents in which different elements are combined from prior art to achieve a new and useful apparatus and/or method. Although Applicants' invention may appear to combine elements found in different prior art disclosures, the motivation to combine the references must be in the prior art not in Applicants' pending claims. There is no motivation in the prior art to combine the reference, since such a combination would go against the teaching of *Kitamura et al.*.

It is well settled that each statement of obviousness for the purpose of combining each of the numerous references of record must be found and suggested in the references themselves and not only in the fertile mind of the Examiner. The conclusive statements of the Examiner must be based upon specific evidence, suggestions and findings in the references of record relied upon by the Examiner in the rejection of the claimed subject matter. It is respectfully submitted that the record before us lacks any valid reasons to combine the references in the manner done so by the Examiner and contains unsupported reasoning suggested by the Examiner. The Examiner has not established a prima facie case of obviousness with respect to the aforesaid set of claims, there being no motivation to combine the references other than that disclosed in the Applicants' specification. "The best defense against the subtle but powerful attraction of a hindsight-based

¹³ *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992), citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991).

obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references".¹⁴ It is respectfully suggested that the Examiner's rejection under 35 U.S.C. §103(a) which contains neither teachings nor motivation to combine the references is without merit and must be withdrawn. Accordingly, Applicants respectfully contend that the combination of *Kitamura et al.* with *Imamura et al.* does not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests that the Examiner remove the rejection and direct allowance of claims 1, 3-5, 7, 8, 10-12, 14, and 16-20.

With respect to claims 4, 5, 11, and 12, Applicants claim a type field to indicate node ownership or cluster ownership, respectively. The Office Action does not specify which prior art reference, *Kitamura et al.* or *Imamura et al.*, is being alleged to teach the elements of these two claims. In fact, it appears from the language of the Office Action that the Examiner is indicating that these elements are not found in either *Kitamura et al.* or *Imamura et al.*. As noted in the Office Action Response dated December 7, 2005, "There is no teaching in *Kitamura et al.* for either a node identifier or a cluster identifier to determine access rights of a node to storage media. The identifier of *Kitamura et al.* is limited to a port identifier."¹⁵ *Kitamura et al.* does not teach or suggest a node identifier or a cluster identifier as a basis for the access right determination. Similarly, with respect to *Imamura et al.* and as noted in the Office Action Response dated December 7, 2005, "a disk identifier and a memory identifier are not equivalent or substitutable for a node and/or cluster identifier and do not determine access rights of a node to storage media."¹⁶ "To establish a prima facie case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations."¹⁷ The Examiner is not citing any location in the prior art reference, or a specific prior art reference, that identifies

¹⁴ *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

¹⁵Office Action Response dated December 7, 2005, page 11.

¹⁶See Office Action Response of December 7, 2005, page 11.

¹⁷MPEP §2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

node ownership or cluster ownership in the manner claimed. Applicants hereby maintain their position that neither *Kitamura et al.* nor *Imamura et al.* teach or suggest the node and/or cluster identifier(s) as claimed by Applicants. Accordingly, Applicants respectfully request that the Examiner remove the rejection of claims 4, 5, 11, and 12 and grant allowance thereof.

With respect to claims 19 and 20, the Examiner uses a double negative to teach the omitted element. More specifically, the Examiner states, “Regarding claim 19, *Imamura* does not teach that the label does not contain a type field and node identifier. Regarding claim 20, *Imamura* does not teach that the label does not contain a type field and a cluster identifier.”¹⁸ As noted above, “To establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations.”¹⁹ It is clear in the law that the prior art must teach the claim limitations and the fact that the prior art does not teach that it does not contain a specific element is not sufficient to overcome the omitted element. The prior art must positively teach the omitted element of the claim limitation. Since the Examiner has not cited a teaching of the node and cluster identifiers in the manner claimed by Applicants, Applicants hereby maintain their position that neither *Kitamura et al.* nor *Imamura et al.* teach or suggest the node and/or cluster identifier(s) as claimed by Applicants. Accordingly, Applicants respectfully request that the Examiner remove the rejection of claims 19 and 20 and grant allowance thereof.

IV. Conclusion

Applicants believe that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Accordingly, Applicants request that the Examiner indicate allowability of claims 1, 3-8, 10-14, and 16-20, and that the application pass to issue. If the Examiner believes, for any reason, that personal

¹⁸Office Action dated December 7, 2006, page 5.

¹⁹MPEP §2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

communication will expedite prosecution of the application, the Examiner is hereby invited to telephone the undersigned at the number provided.

For the reasons outlined above, withdrawal of the rejection of record and an allowance of this application are respectfully requested.

Respectfully submitted,

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